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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,580	01/23/2004	John Carney	007412.01075	7727
71867 7590 06/22/2010 BANNER & WITCOFF, LTD ATTORNEYS FOR CLIENT NUMBER 007412 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
PARRA, OMAR S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,580

Applicant(s)

CARNEY ET AL.

Examiner

OMAR PARRA

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10,11,22,23,25-28 and 30-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10,11,22,23,25-28 and 30-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the art of record, Begeja, Holtz and McCoskey do not teach or suggest the *"wherein one or more additional VOD clips are included as component VOD clips of the composite VOD clip, the one or more additional VOD clips including an advertising VOD clip selected from a plurality of advertising VOD clips based on the selected VOD clip categories"*, Remarks section, page 11. To this matter, the examiner respectfully disagrees.

The Begeja reference clearly teaches that the system is able to insert in the composite video advertisement related to the subject of the stream ([0087]); and given that the stream is composed of video clips selected from categories and sub-categories selected by the user ([0026]; [0051]; [059]), then the advertisement clips are selected based on the selected VOD clip categories.

Applicant argues that the art of record does not teach or suggest *"including an advertisement based on...at least one video clip metadata search attribute"*, Remarks pages 13 and 14. To this matter, the examiner respectfully disagrees.

According to the clarification on the meaning of the terms by the attorney during the interview on February 26th, 2010, the terms 'category', 'metadata

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search attribute' and 'parameters' equate to 'category', 'sub-category' and values that affect the selection/presentation respectively. In the example given, 'category' means the categories 205, 207, 210, 215 and 220 of Fig. 2; 'metadata search attribute' represents sub-categories 206, 209 and 209 of the same figure. On the other hand, 'parameters' represent the values presented on Fig. 3.

Begeja teaches that the user is able to select categories and sub-categories for the system to create a composite video based on user's selection ([0026]; [0051]; [0059]). Begeja clearly teaches that the system is able to insert in the composite video advertisement related to the subject of the stream ([0087]); and given that the stream is composed of video clips selected from categories and sub-categories selected by the user ([0026]; [0051]; [0059]), then the advertisement clips are selected based on the selected VOD clip categories.

Therefore, the examiner respectfully believes that the art of record still covers applicant's invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims **22, 31 and 37** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a

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way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

After closing reviewing applicant's specification, the newly added limitation "*includes an advertisement based on...at least one video clip metadata search attribute*" on claims 22, 31 and 37, has no support on the specification.

The only portions on the specification that is related to inserting advertisement are paragraphs [0030]-[0032]. The mentioned paragraphs talk about inserting advertisement based on the selected category, but is silent on selecting advertisement based on *at least one video clip metadata search attribute* or the combination of the category and the metadata search attribute as recited on the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **1, 2, 4-8, 10, 11, 22, 23, 25-28 and 30-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Begeja et al. (hereinafter 'Begeja', Pub. No. US 2003/0030752, of record) in view of Holtz et al. (hereinafter 'Holtz', Patent No. 6,760,916, of record).

Regarding claims 1, 22 and 31, Begeja teaches a method comprising:

transmitting, to the receiving device from the server, one or more video-on-demand (VOD) clip categories, each VOD clip category containing one or more corresponding VOD clips (**server 230 transmits all the data needed on the web page that the user has to log in to select the content. The server transmits even the pull-down interface of the shows and categories, [0047]; [0054]; [0051]**); receiving, at the server from the device, user input specifying selected ones of the VOD clip categories (**servers 220 and 225 receive and handle all the user requests that define the type of content they want, [0045]-[0046]**); one or more VOD clip metadata search attributes, each of the VOD clip metadata search attributes configured to filter one or more VOD clips corresponding to a respective one of the VOD clip categories; receiving, at the server from the receiving device, user input specifying one or more VOD clip metadata search attributes for one or more of the selected VOD clip categories (**the system generates metadata, 215, 225, Fig. 2; [0023]; [0044], by analyzing the video content, [0038]-[0041]. This metadata contains attributes or characteristics that describe the video content and are used for the search of the video, [0024]; [0044]. The user is able to search the metadata by specifying the category or topic and the subtopics that define the clips he/she desires, [0026]; [0051]; [0059]; [0061]; [0070]. The system, then, selects the video clips that have those characteristics, and in this way, filtering out the ones that don't, [0055]; [0060]**); and

creating, at the server, the composite VOD clip to include one or more corresponding VOD clips from each of the selected ones of the VOD clip categories assembled according to the selected VOD clip parameters of each selected VOD clip category and filtered according to the one or more received VOD clip metadata search attributes for each selected VOD clip category ([0025]; [0026]; [0059]);

wherein one or more additional VOD clips are included as component VOD clips of the composite VOD clip ([0025]; [0026]), the one or more additional VOD clips including an advertising VOD clip selected from a plurality of advertising VOD clips based on the selected VOD clip categories ([0079]; [0087]).

Additionally, for claims 22, 31 and 37, Begeja teaches that the client could be a computer, a set-top box, etc ([0054]; [0058]), which inherently at least possesses a processor and memory for executing instructions. The same goes for the servers.

Begeja clearly teaches that the system is able to insert in the composite video advertisement related to the subject of the stream ([0087]); and given that the stream is composed of video clips selected from categories and sub-categories selected by the user ([0026]; [0051]; [0059]), then the advertisement clips are selected based on the selected VOD clip categories.

On the other hand, Begeja does not explicitly teach transmitting, to the receiving device from the server, one or more VOD clip parameters, each of the VOD clip parameters defining how individual ones of the VOD clips from the

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selected ones of the VOD clip categories will be assembled into a composite VOD clip.

However, in an analogous art, Holtz teaches a VOD multimedia production and distribution system that assembles a media production from a variety of sources based on personal preferences (Abstract). The user is able to see and access the data on an internet portal in order to interact and request content; therefore, the information displayed on the user's client needs to be transmitted from the server (col. 12 line 36-col. 13 line 3). Holtz teaches that for setting the user preferences or the type of content he/she wants, a VOD clips attribute selection functionality is presented to him/her in order to let the system know what categories are desired, how long he/she wants the production or clips to be, etc (col. 13 lines 3-31; col. 16 line 4-col. 17 line 5; col. 31 line 18-col. 32 line 64). By specifying the length of the video, the number of segments is affected. In other words, the higher the length of the video is, the higher the number of segments included, and vice versa. In other words, this selection affects how the individual ones of the VOD clips will be assembled into the composite video clip. Holtz also explicitly teach that the number of video segments can also be selected (col. 16 lines 42-45).

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Begeja's invention with Holtz's feature of letting the user to define video clips attributes through an interface for the benefit of providing to the user a neat, easy to fill up interface for customizing the video clips or content to be received.

Regarding claims 2 and 23, Begeja and Holtz teach further comprising presenting the composite VOD clip to a user to effect a passive viewing experience (**Begeja: [0053] lines 19-20**).

Regarding claim 4, wherein the composite VOD clip consists of a subset of the one or more VOD clips corresponding to the selected VOD clip parameters in each selected VOD clip category (**Begeja: 565, Fig. 5. Holtz: col. 13 lines 3-31; col. 16 line 4-col. 17 line 5; col. 31 line 18-col. 32 line 64**).

Regarding claims 5, 25 and 32, Begeja and Holtz teach wherein the one or more VOD clip parameters includes a VOD clip parameter selected from the group consisting of a random selection parameter, a maximum number parameter, a maximum time parameter, and a sequential parameter (**Holtz: col. 13 lines 3-31; col. 16 line 4-col. 17 line 5; col. 31 line 18-col. 32 line 64. Begeja: 420, Fig.4, "Play all clips" without knowing what's going to play is a random selection; ([0065])**).

Regarding claims 6, 26 and 33, Begeja and Holtz teach further comprising:

automatically regenerating the composite VOD clip (**[0026]**) upon user request ("**instant search**", **[0058]**) or according to an externally specified schedule ("**...on a periodic basis...**" **[0026]**).

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Regarding claim 7, 27 and 34, Begeja and Holtz teach wherein the one or more corresponding VOD clips made available prior to a specified time (**405, Fig.4, videos are available prior user's selection**) are removed from the composite VOD clip ("**AT&T, 8 clips**", "**Jay Lenos White H... 10 clips**", "**Sports, 6 clips**", see Fig.4, are removed after choosing "**Politics**"; 505, Fig. 5).

Regarding claims 8, 28 and 35, Begeja and Holtz teach further comprising:

wherein removing the one or more corresponding VOD clips previously presented to a particular user from the user's composite VOD clip (**Holtz: col. 43 lines 29-36**).

Regarding claims 10, 30 and 36, Begeja and Holtz teach wherein the one or more additional VOD clips comprise VOD clips selected from the group consisting of advertising VOD clips (**[0057]**), promotional VOD clips pertaining to VOD content unrelated to the composite VOD clip ("**Additional marketing and advertising (such as a commercial...)**", **[0057]**), and promotional VOD clips pertaining to VOD content related to the composite VOD clip (**[0087]**).

Regarding claim 11, Begeja and Holtz teach wherein one or more additional graphical or data contents, including content tickers, graphical ads or promotional contents unrelated to the composite clip video, and content tickers,

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graphical ads or promotional contents related to the composite clip video, are added alongside or partially overlay the composite video ([0087] paragraph lines 5-7 or also, 555, Fig.5).

Regarding claims 38-40, Begeja teaches wherein the receiving device includes a set-top box (Begeja: [0058]).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is

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(571)270-1449. The examiner can normally be reached on 9-6 PM (M-F, every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

OP